

### **REMARKS/ARGUMENTS**

Claims 1-24 are pending. Claim 19 is amended to depend from claim 13.

New claims 25 and 26 are added calling for fingers that are longer than the width of each respective device. Support is found in Figs. 1-5. Accordingly, no new matter is added.

#### **Rejections under 35 USC § 102**

The rejection of claims 1-12 as anticipated by U.S. Patent No. 5803096 to Lee is respectfully traversed. The Patent Office has established a standard by which prior art must be judged to satisfy anticipation. The standard is set forth in MPEP § 2131, which states in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)....."The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claims 1-8 call for a device having a combination of curved inner surfaces that are extendable around more than one-half of an unused standard paper media roll. According to paragraph [0010], the outer radius of a standard toilet paper roll is at least 3" and the outer radius of a standard paper towel roll is at least 4.5". Therefore, to extend around more than one-half of an unused standard paper media roll, the combination of inner surfaces must be able to accommodate a 6" diameter toilet paper roll or a 9" diameter paper towel roll. Nothing in the Lee patent shows a hair clip capable of accommodating a paper roll of these dimensions. Lee describes a hair clip without specifying any size, and none of the drawings show a hair clip that can fit around a 6" diameter. For example, Fig. 6 shows an open hair clip (column 2, line 29), but the clip is not big enough to fit around a roll of toilet paper. Lee does not teach or describe every element of claims 1-8, and fails to show "in as complete detail" the device contained in the claims. Accordingly, claims 1-8 are not anticipated.

Moreover, the hair clip of Lee cannot inherently accommodate a paper roll. Inherency requires that the claimed characteristic necessarily flows from the prior art - the "mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP 2112(IV). In this case, as expected from the small size of typical hair clips, and as shown in the figures of Lee, the hair clips described by Lee are much smaller than the size necessary to fit around a 6" diameter toilet paper roll or a 9" diameter paper towel roll. Because Lee's hair clips do not

necessarily accommodate a roll of toilet paper or paper towels, claims 1-8 are not inherently anticipated.

Similarly, claims 9-12 call for a device having arcuate surfaces, with each arcuate surface having a radius at least as large as the outer radius of an unused toilet paper roll (3") or paper towel roll (4.5"). As with claims 1-8 discussed above, Lee does not specifically teach or describe a hair clip having arcuate surfaces with radii of 3" or greater, and the hair clips of Lee can have radii much smaller than 3". Therefore, Lee does not explicitly or inherently teach the device called for in claim 9-12.

Lee does not show the claimed inventions "in as complete detail" as contained in claims 1-12. As such, Lee fails to teach or suggest each and every element of the claims. Accordingly, claims 1-12 are neither explicitly nor inherently anticipated.

### Rejections under 35 USC § 103

The rejections of claims 13-24 as obvious over the Lee patent in view of U.S. Patent No. 4,137,818 to Loranger is respectfully traversed.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. In the present case, the prior art does not meet this standard.

Claims 13-24 call for placing a paper media roll, toilet paper roll or paper towel roll between first and second arcuate surfaces. In contrast, neither Lee nor Loranger describe or even mention paper media, toilet paper or paper towel rolls. Because the references do not teach or suggest all claim limitations, claims 13-24 are not obvious.

Moreover, Lee is concerned with a hair clip. Loranger is concerned with a tatting shuttle for carrying needlework thread. Even if Lee were combined with Loranger in the way suggested in the Office Action, Lee would be applied to holding needlework thread, not paper media rolls. The combination of Lee and Loranger fails to teach all claim limitations. Accordingly, claims 13-24 are not obvious.

Further, to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. The mere fact that references can be combined is not enough. MPEP § 2143.01. Rather, the prior art must suggest the desirability of combining the references. *Id.* In the present case, the references fail to meet this standard.

Lee is concerned with a hair clip. Loranger is concerned with a tatting shuttle for carrying needlework thread. Because the Lee and Loranger patents are directed to completely different subject matter, there is no reason or motivation to combine the references.

Furthermore, because both references are completely silent as to paper rolls, there is no reason or suggestion to combine the references for application to toilet paper or paper towel rolls. Indeed, the only suggestion to combine Lee and Loranger comes from the present application

itself. Thus, any suggestion to combine the references is based on improper hindsight. Because there is no valid reason or motivation to combine the references, claims 13-24 are not obvious.

With regard to new claims 25 and 26 calling for fingers that are longer than the width of their respective devices, nothing in Lee or Loranger teaches or suggests devices with such finger dimensions. Indeed, Figs. 1, 2, 4, and 7-10 of Lee, and Figs. 5 and 6 of Loranger, show devices with fingers that are much shorter than the width of each respective device. Therefore, claims 25 and 26 are neither anticipated nor obvious.

In view of the foregoing amendments and remarks, Applicants submit that the present application is in condition for allowance. A Notice of Allowance is therefore respectfully requested.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

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Respectfully submitted,



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